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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,128	12/30/2000	Yosef Freedlan	JST-15	1786

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EXAMINER

ODLAND, KATHRYN P

ART UNIT PAPER NUMBER

3743

DATE MAILED: 04/19/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/753,128

Applicant(s)

FREEDLAN, YOSEF

Examiner

Kathryn Odland

Art Unit

3743

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 64,66-71,73,74,79,81-89,94,96-98,100-104,109,111,113,115-119 and 134-137.

Claim(s) withdrawn from consideration: 1-63,65,72,75-78,80,90-93,95,99,105-108,110,112,114 and 120-133.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: Applicant's remarks have been carefully considered and it is understood that the invention is directed to the medical art. However, applicant has added new matter to the claims that are not supported even through the incorporation by reference. There is no disclosure or support in 09/753,128 that the split nut contacts tissue. The embodiments disclosed in 6,162,234 are quite different than the elected species of 09/753,128 and the incorporation by reference would not lead one with ordinary skill in the art to assume nor conclude that the split-nut elected specie demonstrated in 09/753,128, figures 118-131, would necessarily contact tissue, as recited in the amended claims. Applicant's attention is directed to figures such as 3-20 in the application 09/753,128, which show a split nut inside a cup. Thus, since it was not originally disclosed that the split nut of elected species 118-131 contacts tissue, one with ordinary skill could not ascertain where the split-nut is used and what is contacted. Further, even though there is incorporation by reference to 6,162,234, this patent does not disclose the embodiment of the elected species of figures 118-131. Therefore, it cannot be correlated that the different embodiments shown in 6,162,234 would necessarily be used in a similar manner. Having multiple embodiments allows for variations of the invention to be used in different manners, so the disclosure of one species cannot be necessarily translated to a separate and distinct species.

Further, applicant has not positively claimed a suture. In fact claim 67, recites an elongate element that is at least one of a wire and a suture. Thus, the prior art rejection is not unlike that claimed in the current application. Further, applicant's arguments (such as two elongate elements, dissolvable, etc.) are directed to the various species discussed in Patent No. 6,162,234, which are different from the elected species of the current application. Applicant's claims can only be directed to the species elected, where the incorporation by reference would have had to also demonstrate that specie. There is no disclosure in 09/753,128 that the specie of figures 118-131 is dissolvable and it cannot be correlated that since other embodiments in an incorporated by reference patent are perhaps dissolvable that likewise that shown in figures 118-131 is as well. Applicant further states, "Fig. 121 of the present invention shows band B in the lower position so that its bottom edge is in contact with a tissue and Fig. 130 shows the band B in the upper position so that its bottom edge is not in contact with a tissue surface." However, no tissue is shown nor discussed with regard to figures 121 and/or 131

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